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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,224	11/17/2004	Shinro Oyama	2004-0995A	7499

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WENDEROTH, LIND & PONACK, L.L.P.
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SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

KASHNIKOW, ERIK

ART UNIT	PAPER NUMBER
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1709

MAIL DATE	DELIVERY MODE
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10/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/500,224

Applicant(s)

OYAMA ET AL.

Examiner

Erik Kashnikow

Art Unit

1709

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 25 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06/25/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :08/31/2006, 12/09/2005, 09/24/2004.

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 23 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/562,447. Although the conflicting claims are not identical, they are not patentably distinct from each other because the tensile strength of 80N/mm² or higher would cover the limitation of 900 N/mm² put forth in claim 1 in application No. 10/562,447. Claim 1 of application No. 10/562,447 specifies the tensile strength in both the circumferential direction and a tube axial direction, where as Claim 23 is silent regarding the direction, the specification does say the tensile strength is measured in both directions (page 29 line 9-15).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 7, 11, 13-18, 23-26 and 49-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeuchi et al. (5,944,930).

5. Takeuchi et al. teach a tubular film with a highly uniform film thickness (Column 2 line 8-9). Takeuchi et al. teach that the tubular product can be wound on a columnar member a plurality of times to make said tube (claim 4).

6. They teach the thickness of the film is from 5-300 μm which satisfies applicant's requirement of 20 μm or lower (column 3 line 21-23). They also teach that the film thickness of the finished tube product be around 50 μm (Column 9 lines 34-36).

7. Takeuchi et al. teach that polytetrafluoroethylene can be used as the film for the tubular product (column 16 lines 28-34). Takeuchi et al. also teach tensile strengths greater than 800N/mm² (Figure 41), that their present invention particularly relates to a

conveyor or image fixing film or belt for a toner carrier (column 1 line 11-12) and a fixing device or conveyor unit using the film (column 1 line 49-52).

Claim Rejections - 35 USC § 103

8. Claims 1-7, 9-27, 34-39, and 41-46, 48-54 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi et al. (5,944,930).

9. As stated above, Takeuchi et al. teach a tubular film for use as an image fixing film or belt for a toner carrier. Takeuchi et al. also teach applying a primer to an outer surface layer of the film to help with adhesion (column 16 43-45); However Takeuchi et al. are silent regarding applying the primer to an inner surface. None the less, it would be obvious to one of ordinary skill in the art to an outer surface layer but to all surface layers that might require an improvement of adhesion property.

10. Takeuchi et al. also teach belts and tubular films for use as in image fixing devices. However Takeuchi et al. are silent regarding fixing rolls, and devices using fixing rolls. Takeuchi et al. do teach an image-fixing device that uses rollers (column 9 line 66 – column 10 line 4). It would be obvious to one of ordinary skill in the art at the time of the invention to use the tubes made from the film as the rollers in this device.

11. Takeuchi et al. teach a surface roughness of the inner layer of the outer mold of 3 μm or less (column 11 line 55-56). They are silent regarding the surface roughness of the film. It would however be obvious to one of ordinary skill in the art that since there would be no other part of the rest of the process where roughness could be introduced, the surface of the film would have a surface roughness that was about 3 μm or less which includes films with surface roughness less than 0.5 μm .

12. Claims 8, 28-33, 40, 47, 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi et al. (5,944,930) in further view of Okamura et al. (6,104,530).

13. As stated above et al. Teach a tubular film for use as an image fixing film or belt for an image-transferring device. However Takeuchi et al. are silent regarding the light transmittance of the fluororesins. Okamura et al. teach a multilayer film for displays that has visible light transmittance of not less than 50% (column 6 lines 14-16). Okamura et al. teach that such films often need a gas impermeable barrier layer, and that fluororesins can be used for the gas barrier. (column 16 line 9-17). They also teach that this protective layer also be transparent (Column 15 lines 41-46). It is known to those of ordinary skill in the art at the time of the invention that 500nm is within the range of the visible light spectrum. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention that the tubes of Takeuchi et al. could be made form a fluororesin film with a light transmittance of greater than 50% at 500 nm.

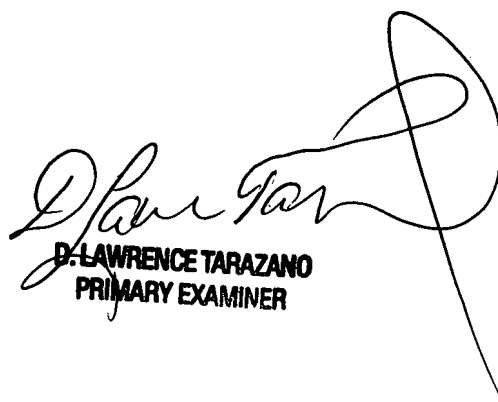
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erik Kashnikow whose telephone number is (571) 270-3475. The examiner can normally be reached on Monday-Friday 7:30-5:00PM EST (First Friday off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Lawrence Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



D. LAWRENCE TARAZANO
PRIMARY EXAMINER

Erik Kashnikow
Examiner
Art Unit 1709